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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/666,877 | 09/20/2000 | Daniel J. Mendez | 43630.00045 | 1506 |

30256 7590 07/18/2002

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EXAMINER

GECKIL, MEHMET B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2152

DATE MAILED: 07/18/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,877

Applicant(s)

MENDEZ ET AL.

Examiner

Mehmet B. Geckil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 83-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 83-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

1. Claims 83-96 are presented for examination.
2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention and failing to adequately teach how to make and use the invention, i.e. failing to provide an enabling disclosure.

Applicant did not teach the details of how the smart phone, a television settop box provided workspace data including the differences as claimed in claims 86 and 93. It would take undue experimentation for one of ordinary skill in the art at the time of the invention to determine the details of the smart phone and a television settop box as claimed in the claims. Also, applicant on page 23 of the specification stated in a summary fashion that although not shown, other services such as bookmarking may be included in the list. This kind of information is not enabling. The specification is the place where applicant must teach the details of the features of the invention if the applicant wants to claim such features in the claims. It would take further undue experimentation for one of ordinary skill in the art to determine the details of the bookmark data as claimed in claims 85 and 92.

The examiner contends that it would require repeated undue experimentations for one of ordinary skill in the networking art to make and use the claimed invention for the reasons set forth hereinabove. Applicant is reminded that no new matter is allowed in the amendment to the specification under 35 U.S.C. 132 and 37 CFR 1.118(a).

3. Claims 85-86 and 92-93 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 83-96 are rejected under 35 U.S.C. 102(a) as being anticipated by Salesky et al (6,343,313).

6. Salesky et al (6,343,313) taught the invention as claimed including a system comprising:

- a) means for storing first workspace data on a first device (12, col 7 line 35 et seq);
- b) means for storing second workspace data on a second device (18, col 8 line 3 et seq);
- c) means for determining differences between the first workspace data and the second workspace data (col 7 lines 38-65);
- d) means for storing the differences at a global server (col 7 lines 66-67); and
- e) means for sending the differences from the global server to the second device (col 8 line 1 et seq.)

7. As to claims 84 and 91, the first workspace data comprises a workspace data element from a first user or conferee of the first device to a second user or conferee of the second device (col 7 line 23 et seq.)

8. As to claims 87 and 94, the system further comprised of means for continuing to store the differences at the global server is continued after the sending (col 7 line 25 et seq.)

9. As to claims 88 and 95, the system further comprised of storing at the server version-indication information or time-stamps (col 7 lines 60-65.)

10. As to claims 89 and 96, the system further comprised of means for merging or updating by the second device, the differences with third workspace data stored on the second device (col 8 line 5 et seq.)

11. As to claims 85-86 and 92-93, these features are inherently provided by the teachings of Salesky et al because Salesky et al system was a web based system. Web was invented to provide various services to the users, e.g. email, database, calendar, ftp, html are all essentials of the web based systems. Applicant also on page 23 of the specification stated that although not shown, other services such as bookmarking may be included in the list. Examiner is using the same rational here and saying that these features are inherent part of the web based systems and there may be more to be added to this list of services.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehmet Geckil whose telephone number is (703) 305-9676. The examiner can normally be reached on Monday through Friday from 6:30 A.M. to 3:00 P.M..

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-9731.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5359 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

3/15/00

**MEHMET B. GECKIL
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "Mehmet B. Geckil", written in a cursive style.